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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,913	09/15/2003	Jiann-Chen Chen	N81438/LPK	1253
1333 7590 04/10/2008 EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201			EXAMINER TSOY, ELENA	
			ART UNIT	PAPER NUMBER
			1792	
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			04/10/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,913

Applicant(s)

CHEN ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8-11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-11, 14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Request for Reconsideration

The Request for Reconsideration filed on November 20, 2007 has been entered. No claims have been added or cancelled. Claims 1-3, 5-6, 8-11, and 14-18 are pending in the application. Claim 15 is withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons of record set forth in paragraph 2 of the Office Action mailed on 10/15/2007.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-6, 8-11, 14 and 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art (AAA) in view of Weber et al (US 5,750,160) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 10/15/2000.
5. Claims 1-3, 5-6, 8-11, 14 and 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over AAA in view of Weber et al, further in view of Hartley et al (US 4,853,737)

and Chen et al (US 5,781,840) for the reasons of record set forth in paragraph 7 of the Office Action mailed on 10/15/2000.

6. Claims 1-3, 5-6, 8-11, 14 and 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over AAA in view of Weber et al/AAA in view of Weber et al, further in view of Hartley et al and Chen et al/, and further in view of Badesha et al (US 5,141,788) for the reasons of record set forth in paragraph 8 of the Office Action mailed on 10/15/2000.

7. Claims 1-3, 5-6, 8-11, 14 and 16-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over AAA in view of Weber et al/AAA in view of Weber et al, further in view of Hartley et al and Chen et al/, and further in view of Petropoulos et al (US 5021109) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 10/15/2000.

8. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over AAA in view of Weber et al/AAA in view of Weber et al, further in view of Hartley et al and Chen et al/, and further in view of Mikkelsen (US 6,071,110) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 10/15/2000.

9. Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over AAA in view of Weber et al, further in view of Hartley et al and Chen et al, and further in view of Schlueter, Jr. et al (US 5,995,796) for the reasons of record set forth in paragraph 11 of the Office Action mailed on 10/15/2000.

DECLARATION of JIANN H. CHEN & JOSEPH A. PAVLISKO UNDER 37 C.F.R. §132

It is noted that both Jiann H. Chen and Joseph A. Pavlisko, the Declarants, are inventors in the pending application, issued '084 patent filed simultaneously herewith and the references cited in the Information Disclosure Statement for the instant application. Thus, the Declarants are an inventive entity in both the pending application and the applied reference. Declarants seek to show herein, that the preamble of the Jepson format claim included in the instant application

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describes Declarants own work. We, the Declarants, have worked on replaceable fuser members. This work included obtaining high temperature nickel mandrels and applying primer coatings of a silane coupling agent that contains epoxies to the outer surface of the mandrel. An elastomer was then applied and cured on the outer surface of the mandrel. This elastomer was machined to a desired thickness. A topcoat layer was applied over the machined coating of the base cushion and cured. The elastomer and topcoat formed a replaceable fuser member sleeve that was removed from the mandrel. The mandrel has a coefficient of thermal expansion equal to from about 80 to about 120 percent of the coefficient of thermal expansion of the sleeve in a temperature range from about 20 to about 325°C.

In other words, the Declarants Jiann H. Chen and Joseph A. Pavlisko declare that since the preamble of the Jepson format claim of original claim 19 is Declarants' own work, the rejection has to be withdrawn.

However, the fact that the preamble of the Jepson format claim of original claim 19 is Declarants' own work, is *insufficient* to overcome the rejection of claims 1-3, 5-6, 8-11, 14 and 16-18 based upon the cited prior art because as was explained in detail in *paragraph 7 of the Office action mailed on 10/10/2006*, **the limitations of the preamble were well known in the art, as evidenced by Hartlev et al (US 4,853,737) and Chen et al (US 5,781,840).**

Therefore, the Declaration under 37 CFR 1.132 filed on November 20, 2007 is insufficient to overcome the rejection of claims 1-3, 5-6, 8-11, 14 and 16-18 based upon the cited prior art.

Response to Arguments

Applicants' arguments filed November 20, 2007 have been fully considered but they are not persuasive.

Claims 1-3, 5-6, 8-11, 14 and 16-18 are rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.

The Examiner states that the limitation of "curing the topcoat layer at a temperature of 275°C or more" is not described in the specification in such a way as to enable a person skilled in the art to make/or use the invention. The Examiner takes issue that there is no upper limit. The Examiner asserts that there is no way to heat the topcoat layer to a temperature of 1,000,000°C. Under MPEP 706.3 "The primary object of the examination of an application is to determine whether or not the claims are patentable over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to nonprior art or "technical"

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rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression...". In the instant application, one skilled in the art could, without undue experimentation, determine the upper limit of the curing temperature, when the topcoat composition no longer cures and decomposes. Applicants did not commit resources to finding the upper limit. Applicants assert that the technical nature of this rejection is not critical and as such is a violation of MPEP 706.3 and request that this rejection be removed.

The Examiner respectfully disagrees with this argument. Under MPEP 2164.08 [R-2]

"When a range is claimed, **there must be reasonable enablement of the scope of the range**".

Here, the claims at issue encompassed curing at temperature of 275⁰C or more, however the specification included statements of curing up to a temperature of *about* 275⁰C or more (See Published Application, P 38).

Therefore, in contrast to Applicants argument, it seems that the Applicants' specification limits the curing to *about* 275⁰C. Moreover, if one skilled in the art could, without undue experimentation, determine the upper limit of the curing temperature, why a temperature of more than 275⁰C was incorporated when the Applicants' specification limits the curing temperature generally to up to a temperature of *about* 275⁰C, i.e. the temperature of *about* 275⁰C or less than *about* 275⁰C ?

Rejection under 35 U.S.C. 103(a)

Applicants assert that the implication is overcome by this evidence provided. As further evidence that the Jepson preamble is not an implied admission, all of the references cited in the Background of the Invention section of the Application contain Jiann H. Chen and Joseph Pavilsko as common inventors. Once this implied admission is overcome as Applicants believe they have done, the Examiners obviousness rejection fails.

The argument is unconvincing for the reasons discussed in the Response to Declaration above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy, Ph.D.
Primary Examiner
Art Unit 1792

April 9, 2008

/Elena Tsoy /

Primary Examiner, Art Unit 1792